

REMARKS

Claims 3-11, 14-22 and 28-30 are all the claims pending in the application. Claims 3-5, 8-11 and 28-29 are amended.

I. Claim Objections

The Examiner objected to claims 3-11 and 14-22 under 37 C.F.R. § 1.75(c) as being in improper form because they do not depend on a preceding claim. The Examiner indicated that dependent claims must “refer back to” the claim upon which they depend from.

The Applicant thanks the Examiner for the telephone discussion on October 5, 2009, in which the Examiner and the Applicant’s Representative discussed the objection to the claims. The Applicant appreciates the Examiner’s willingness to defer objection to the numbering of the claims until an allowable set of claims is determined and can be renumbered before issuance.

The Applicant also notes the Examiner’s objections to claims 28 and 29 for claim limitations which lack proper antecedent basis. The Applicant amends claims 28 and 29 to correct all of the antecedent basis issues in these claims.

II. Claim Rejections Under 35 U.S.C. § 112

The Examiner rejected claims 3-11, 28 and 30 under 35 U.S.C. § 112, first paragraph, as failing to comply with the enablement requirement. The Examiner specifically rejected the use of “means that” in claim 28, as implying an improper single-means claim and in possibly invoking “means for” language pursuant to 35 U.S.C. § 112, sixth paragraph.

The Applicant herein amends claim 28 to describe a “control module” as opposed to a “control means.” The Applicant submits that the amendment will eliminate the Examiner’s rejection of claims 3-11, 28 and 30 under 35 U.S.C. § 112, first paragraph.

III. Claim Rejections Under 35 U.S.C. § 103

The Examiner rejected claims 3-11, 14-22 and 28-30 under 35 U.S.C. § 103(a) as being unpatentable over Riggins (US 6,766,454 B1), and in further view of Clark (US 5,490,251) and Katinakis et al (US 6,389,039 B1).

The Applicant amends claims 28 and 29 to further describe that “the second transmission channel is dedicated to the exchange of voice data.” Support for the amendment is found in the Specification on p.11, lines 9-13.

The Applicant submits that neither Riggins, Clark nor Katinakis teach where the second transmission channel is dedicated to the exchange of voice data. The Examiner cites to Katinakis (col. 5, lines 16-22) as teaching a system where data is sent on one channel during a voice connection on a second channel. However, the voice channel in Katinakis is not dedicated to the exchange of voice data, as the novelty of the system in Katinakis is that other data is transmitted on the voice channel during the quiet periods when the speakers are not talking. *Katinakis*, col. 5, lines 18-20. Since Katinakis is directed to increasing a data transfer rate, it attempts to seize control of as many voice and data channels as possible to maximize the amount of data. *Id.*, col. 1, lines 58-61. In fact, Katinakis explicitly teaches away from systems where a voice channel is dedicated to the exchange of voice data. *Id.*, col. 2, lines 57-61. In contrast, the system

described in claims 28 and 29 is not concerned with increasing a data transfer rate, but rather providing services to a user while the user is on a call. Therefore, Katinakis fails to teach exchanging voice data on a second transmission channel, “wherein the second transmission channel is dedicated to the exchange of voice data.” Riggins and Clark also fail to cure the limitations of Katinakis, as neither describe a system where data on one channel is being sent during a voice connection on a second channel. The Applicant thus submits that as neither Katinakis, Riggins or Clark teach or suggest the features of claims 28 and 29, the rejection under 35 U.S.C. § 103(a) should be withdrawn.

The Applicant also submits that there is no reason for one of ordinary skill in the art to combine the teachings of Riggins, Clark and Katinakis. The Examiner cites to Katinakis as teaching data being sent on one channel during a voice connection on a second channel “so as to make services available during said voice connection.” *Office Action*, p. 8, para. 3. However, as mentioned immediately above, Katinakis is directed to a system for transferring data that “seizes additional voice channels or control channels...in order to increase the data transfer rate.” *Katinakis*, col. 1, line 64 - col. 2, line 3. Katinakis provides no teaching or suggestion for making services available during a voice connection, since Katinakis is only concerned with how to transfer data more quickly. The Examiner admits that neither Riggins or Clark provide this teaching, either. The Applicant thus submits that there is no reason to combine Riggins, Clark or Katinakis, and respectfully requests that the rejection under 35 U.S.C. § 103(a) be withdrawn.

As the Supreme Court stated, when determining whether a claim is obvious, “there must be some *articulated reasoning* with some rational underpinning to support the legal conclusion

of obviousness.” *KSR Int’l v. Teleflex Inc.*, 127 S. Ct. 1727, 1741 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) (emphasis added)). All of the references lack this “articulated reasoning” that would lead one of skill in the art to combine the references and arrive at the claimed invention.

The Applicant first notes that the embodiment of claim 28 covers, in a general sense, a server which provides services from a private communication network to a terminal on another communication network. Notably, these services are provided over a first transmission channel while voice data is being simultaneously exchanged on a second transmission channel.

The Applicant contends that none of the cited references, taken alone or in combination, teach or provide any reason for their combination that would lead to a server which provides services from a private network to a terminal on another network during a voice connection. *Riggins* is limited simply to a client/server system for authenticating a user in a network, but never mentions any type of voice connection or even which channels should be used to convey the information. *Riggins*, Abstract. *Riggins* lacks, and the Examiner fails to point out, any *articulated reasoning* for why its system should be combined with Clark or Katenaki.

Clark fails to cure the limitations of *Riggins*, as the Examiner cites to Clark only for the teaching of sending data over a signaling channel. The Applicant notes that it is the sending of data over a signaling channel *simultaneous to* sending voice data over a separate voice channel that is distinguishable over the cited references, and not just the sending of sending data over the signaling channel. Again, Clark lacks any disclosure of the other elements of claim 28, specifically the *simultaneous* use of the signaling channel *and* the voice channel so that private

services can be provided over the signaling channel while a voice connection exists on the voice channel. There is thus no *articulated reasoning* in Clark for combining with Riggins or Katinakis.

Katinakis also fails to cure the limitations of Riggins and Clark, as Katinakis fails to teach that its system is designed to “make at least some of the services offered by the private communication network available to the terminal during the voice connection.” *Claim 28*. Katinakis is designed to increase a data transfer rate by sending data packets *on the same channel* as voice data, as opposed to sending data packets on the signaling channel and voice data on the voice channel. Katinakis does not make any mention of a system to provide private network services to a terminal outside the private network. As Katinakis is designed for a completely different purpose, the Applicant submits that Katinakis also lacks any *articulated reasoning* for combining with Riggins and Clark.

IV. Conclusion

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. If any points remain in issue which the Examiner feels may be best resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

AMENDMENT UNDER 37 C.F.R. § 1.111
U.S. Appl. No.: 10/517,369

Attorney Docket No.: Q84992

Respectfully submitted,

/Scott H. Davison/

SUGHRUE MION, PLLC
Telephone: (202) 293-7060
Facsimile: (202) 293-7860

WASHINGTON OFFICE

23373

CUSTOMER NUMBER

Date: November 4, 2009

Scott H. Davison
Registration No. 52,800